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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/694,734 | 10/23/2000 | Edward M. Housel | 10432/28 | 1165 |
| 757 | 7590 | 12/28/2004 | EXAMINER | |
| BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610 | | | NOLAN JR, CHARLES H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2854 | |

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/694,734

Applicant(s)

HOUSEL ET AL.

Examiner

Charles H Nolan, Jr.

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-9-04 has been entered.

Information Disclosure Statement

2. Applicant is reminded of the duty to disclose cited art from other co-owned applications. The art cited in the rejection here below was from a search report supplied to another Examiner (received by PTO in 2002) in application 10/078,120, which has a common inventor and is co-owned by the same assignee, but not disclosed to this Examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4,6-7,9,14-17,19,21-22,26-28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by MacKay (5,718,520).

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With respect to Claims 1,15, MacKay teaches the user interface 62, the sheet output destinations (output tray 118 or finisher 120 in figure 1) for a portion of multiple sheet print job prior to printing in figures 9 and 14, column 9, lines 37-44 and her claim 9. With respect to Claim 2, MacKay teaches the input source comprising an input paper tray 110 in figure 1. With respect to Claim 3, MacKay teaches the tab media and the colored media in figures 9 and 16. The Examiner has not given any patentable weight to the specific type of tab media because it does not affect the structure of the printing system. With respect to Claim 6, MacKay teaches the output destination comprises output paper trays(stacker) in figure 9 @ job 119. With respect to Claims 7,19, MacKay teaches the output destinations are associated with corresponding processing stations on a page by page basis in figures 12-14. With respect to Claims 4,9-10,22, MacKay teaches the first destination stacker, the second destination bounding and the third destination stitching in column 4, lines 55-62, the central processing function @ 7 in figure 2 and figure 14. With respect to Claims 14,26, MacKay teaches the user interface with buttons to select output destinations on a page by page basis in figures 12-14 for the desired appearance in figure 9. With respect to Claim 16, MacKay teaches the determining and creating steps on the front page diagram. With respect to Claim 17, MacKay teaches the supporting step on the front page diagram, the determining step in figure 9 and the wherein clause recitation in figure 14. With respect to Claim 21, MacKay teaches the supporting step on the front page diagram and the requesting step in figure 14 With respect to Claims 27-28, MacKay teaches the user selection of multiple output destination for multiple group of sheets on the front page diagram and figure 9.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacKay in view of IBM Technical Disclosure Bulletin NB 8106812.

With respect to Claim 8, MacKay teaches all the claim limitations except for the jam handler. IBM teaches the jam handler in the "Disclosure Text." It would have been obvious to one of ordinary skill in the art to incorporate the jam handler of IBM into the invention of MacKay to "shorten the time to problem resolution" as taught by IBM in the "Disclosure Text." With respect to Claim 20, MacKay teaches the supporting step in figure 9 and the determining step in figure 9. MacKay teaches all the claim limitations except for the jam handler. IBM teaches the jam handler in the "Disclosure Text." It would have been obvious to one of ordinary skill in the art to incorporate the jam handler of IBM into the invention of MacKay to "shorten the time to problem resolution" as taught by IBM in the "Disclosure Text."

Allowable Subject Matter

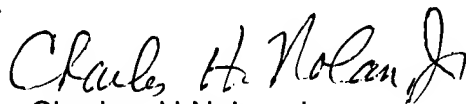
6. Claims 5,11-13,18,23-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The Examiner reserves comment until the entire instant application is in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H Nolan, Jr. whose telephone number is 571-272-2171. The examiner can normally be reached on Monday through Thursday 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charles H Nolan, Jr.
Primary Examiner
Art Unit 2854

CHN